



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/626,205	07/26/2000	Deborah A. Bennett		8168

27510 7590 06/05/2002

KILPATRICK STOCKTON LLP
607 14TH STREET, N.W.
SUITE 900
WASHINGTON, DC 20005

EXAMINER

AKERS, GEOFFREY R

ART UNIT PAPER NUMBER

3624

DATE MAILED: 06/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

59/676205

Applicant(s)

Barnett

Examiner

Akers, G

Group Art Unit

3624

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 7/26/00
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-35 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-35 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 4
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 3624

DETAILED ACTION

1. Note: The benefit of 60/146,523(7/30/1999) and 60/180,288(02/04/2000) is entered.
2. Claims 1-36 have been examined.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-36 are rejected under 35 USC 103(a) as unpatentable over Schein(US Pat.

No:6,226,623) in view of Sandu(US Pat. No:6,347,307).

5. As per claims 1,14,27,29,31 Schein teaches a method of electronic order routing using a global communications network(Abstract) comprising transmitting a selection of available financial instruments and pricing parameters associated with each of said available financial instruments(col 14 lines 36-51) and receiving transactional data wherein the transactional data comprises user account data and user instructional data for a financial instrument(col 14 lines 61-67) and authenticating the data(col 15 lines 12-52) and retrieving financial parameters(Fig 1/34). Schein does not specifically teach calculating a real time market value for the financial instrument. Sandu teaches this(Fig 1/160)(Fig 2/330)(Fig 3)(Figs 11-14) as well as storing(Fig 1/110) managing(Fig 1/170) and using(Fig 1/180/190) this transactional data.It would have been obvious to one skilled in the art at the time of the invention to combineSchein in view of Sandu to teach

Art Unit: 3624

the above. The motivation to combine is to teach a method that enables investors to seamlessly create, price, negotiate, execute and settle capital market transactions including interest and currency derivatives, foreign exchange, loans and deposits and fixed income instruments using a messaging system that permits seamless integration with proprietary existing systems of users as enunciated by Sandu(col 2 lines 1-8).

6. As per claims 2, 6, 15 Schein teaches the method of claim 1, 14 respectively wherein managing the transactional data comprises translating the data into a user specified language and currency(col 18 lines 17-30). Schein does not specifically teach editing, updating, monitoring, maintaining data and generating reports. Sandu teaches editing(Fig 1/210/220), updating(Fig 1/210), maintaining data(Fig 1/110) and generating reports(Fig 1/180/210). Also, Schein does not specifically teach communicating the transactional data among multiple users to complete the order for a financial instrument. Sandu teaches this(col 3 line 36- col 4 line 6). It would have been obvious to one skilled in the art at the time of the invention to combine Schein in view of Sandu, to teach the above. The motivation to combine is to teach a method that enables investors to seamlessly create, price, negotiate, execute and settle capital market transactions including interest and currency derivatives, foreign exchange, loans and deposits and fixed income instruments using a messaging system that permits seamless integration with proprietary existing systems of users as enunciated by Sandu(col 2 lines 1-8).

7. As per claims 3, 16 Schein teaches the method of claims 1, 14 respectively. Schein does not teach further comprising transmitting the transactional data from a broker to a fund manager.

Art Unit: 3624

Sandu teaches this(Fig 1/160/170)(col 2 lines 10-27)(col 5 lines 23-38). It would have been obvious to one skilled in the art at the time of the invention to combine Schein in view of Sandu to teach the above. The motivation to combine is to teach a method that enables investors to seamlessly create, price,negotiate, execute and settle capital market transactions including interest and currency derivatives, foreign exchange, loans and deposits and fixed income instruments using a messaging system that permits seamless integration with proprietary existing systems of users as enunciated by Sandu(col 2 lines 1-8).

8. As per claims 4,17 Schein teaches the method of claims 1,14 respectively. Schein fails to teach further comprising transmitting data from the fund manager to the broker.Sandu teaches this(Fig 1/160/170)(col 2 lines 10-27)(col 4 lines 20-53). It would have been obvious to one skilled in the art at the time of the invention to combine Schein in view of Sandu to teach the above. The motivation to combine is to teach a method that enables investors to seamlessly create, price,negotiate, execute and settle capital market transactions including interest and currency derivatives, foreign exchange, loans and deposits and fixed income instruments using a messaging system that permits seamless integration with proprietary existing systems of users as enunciated by Sandu(col 2 lines 1-8).

9. As per claims 5,18 Schein teaches the method of claims 1,14 respectively. Schein fails to teach comprising generating a payment message with settlement instructions. Sandu teaches this(col 7 lines 28-45). It would have been obvious to one skilled in the art at the time of the invention to combine Schein in view of Sandu to teach the above. The motivation to combine is to teach a

Art Unit: 3624

method that enables investors to seamlessly create, price, negotiate, execute and settle capital market transactions including interest and currency derivatives, foreign exchange, loans and deposits and fixed income instruments using a messaging system that permits seamless integration with proprietary existing systems of users as enunciated by Sandu(col 2 lines 1-8).

10. As per claims 7,20 Schein teaches the method according to claims 1,14. Schein does not specifically teach transferring and verifying commission information. Sandu teaches this(Fig 1/70/80)(col 5 lines 1-10). It would have been obvious to one skilled in the art at the time of the invention to combine Schein in view of Sandu to teach the above. The motivation to combine is to teach a method that enables investors to seamlessly create, price, negotiate, execute and settle capital market transactions including interest and currency derivatives, foreign exchange, loans and deposits and fixed income instruments using a messaging system that permits seamless integration with proprietary existing systems of users as enunciated by Sandu(col 2 lines 1-8).

11. As per claims 8,21 Schein teaches the method of claims 1,14 respectively comprising switching an order to purchase or sell the financial instrument(Fig 2)(col 15 lines 11-22).

12. As per claims 11,24 Schein teaches the method of claims 1,14. Schein does not teach transmitting incremental marketing and valuation data associated with the financial instrument. Sandu teaches this(Fig 1/40). It would have been obvious to one skilled in the art at the time of the invention to combine Schein in view of Sandu to teach the above. The motivation to combine is to teach a method that enables investors to seamlessly create, price, negotiate, execute and settle capital market transactions including interest and currency derivatives, foreign

Art Unit: 3624

exchange, loans and deposits and fixed income instruments using a messaging system that permits seamless integration with proprietary existing systems of users as enunciated by Sandu(col 2 lines 1-8).

13. As per claims 12,25 Schein teaches the method according to claims 1,14. Schein does not specifically teach incorporating data parameters for small intermediaries to compete for financial instruments. Sandu teaches this(Fig 2/350/370/320). It would have been obvious to one skilled in the art at the time of the invention to combine Schein in view of Sandu to teach the above. The motivation to combine is to teach a method that enables investors to seamlessly create, price,negotiate, execute and settle capital market transactions including interest and currency derivatives, foreign exchange, loans and deposits and fixed income instruments using a messaging system that permits seamless integration with proprietary existing systems of users as enunciated by Sandu(col 2 lines 1-8).

14. As per claims 13,26 Schein teaches the method of claims 1,14. Schein does not specifically teach wherein the parameters are realtime real market values. Sandu teaches this(Fig 1/40/60). It would have been obvious to one skilled in the art at the time of the invention to combine Schein in view of Sandu to teach the above. The motivation to combine is to teach a method that enables investors to seamlessly create, price,negotiate, execute and settle capital market transactions including interest and currency derivatives, foreign exchange, loans and deposits and fixed income instruments using a messaging system that permits seamless integration with proprietary existing systems of users as enunciated by Sandu(col 2 lines 1-8).

Art Unit: 3624

15. As per claim 21 Schein teaches the system according to claim 14. Schein does not teach specifically wherein the order comprises an order to purchase, switch or redeem the financial instrument. Sandu teaches this (col 6 line 29-col 7 line 27). It would have been obvious to one skilled in the art at the time of the invention to combine Schein in view of Sandu to teach the above. The motivation to combine is to teach a method that enables investors to seamlessly create, price, negotiate, execute and settle capital market transactions including interest and currency derivatives, foreign exchange, loans and deposits and fixed income instruments using a messaging system that permits seamless integration with proprietary existing systems of users as enunciated by Sandu (col 2 lines 1-8).

16. As per claim 22 Schein teaches the system according to claim 14. Schein does not teach specifically wherein the order comprises an order to purchase, switch or redeem the financial instrument. Sandu teaches this (col 6 line 29-col 7 line 27). It would have been obvious to one skilled in the art at the time of the invention to combine Schein in view of Sandu to teach the above. The motivation to combine is to teach a method that enables investors to seamlessly create, price, negotiate, execute and settle capital market transactions including interest and currency derivatives, foreign exchange, loans and deposits and fixed income instruments using a messaging system that permits seamless integration with proprietary existing systems of users as enunciated by Sandu (col 2 lines 1-8).

17. As per claim 23 Schein teaches according to claim 22 wherein the order to switch further comprises portfolio switching from a first fund to a second fund (col 14 lines 36-45).

Art Unit: 3624

18. As per claims 28,30,35 Schein teaches the method of claims 27,29,31 wherein the secure communications system is a financial institution's communications system(Fig 4/25/33).

19. As per claim 32 Schein teaches the system of claim 31 wherein the interactive user module comprises an application that is downloaded from a web page to the network electronic order routing system(Fig 3/18/12/14/16/40/20).

20. As per claim 33 Schein teaches the system of claim 31 wherein the interactive user module is communicated to the network automateds routing system by one of internet,intranet,extranet(Fig 10)(Fig 11)(Fig 12)(Fig 13)(col 14 lines 35-54)(col 15 line 53-col 16 line 7).

21. As per claim 34 Schein teaches according to the system of claim 31. Schein does not specifically teach wherein the interactive user module comprises one or more user modules cusrtomized for a broker,fund manager,clearing agent,custodian financial service provider or intermediary financial institution. Sandu teaches this(Fig 1/25/80/170). It would have been obvious to one skilled in the art at the time of the invention to combine Schein in view of Sandu to teach the above. The motivation to combine is to teach a method that enables investors to seamlessly create, price,negotiate, execute and settle capital market transactions including interest and currency derivatives, foreign exchange, loans and deposits and fixed income instruments using a messaging system that permits seamless integration with proprietary existing systems of users as enunciated by Sandu(col 2 lines 1-8).

Art Unit: 3624

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Korhammer teaches a securities trading system on electronic exchanges

-Rosen teaches a foreign exchange transaction system

23. Any questions concerning this communication should be addressed to the examiner of record, Dr. Geoffrey Akers, P.E., who can be reached between 6:30 AM and 5:00 PM Monday through Friday at 703-306-5844. If attempts to contact the examiner are unsuccessful, the examiner's superior, Mr. Vincent Millin, SPE, may be telephoned at (703)-308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703)-308-3687. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)-308-1113.

GRA

May 30, 2002